

1 **REMARKS**

2 In the Office Action dated June 29, 2004, the examiner rejected claims 1-47 under 35 U.S.C.  
3 § 103(a) as being unpatentable over Wang et al. U.S. Patent Application Publication No. ( 2002  
4 0121594) ("Wang") in view of Whitehouse et al. U.S. Patent No. 6,403,952. Applicant respectfully  
5 submits that the Examiner's reliance on Wang as prior art is misplaced.

6 Applicant respectfully submits that Wang is not a proper prior art reference under 35 U.S.C.  
7 § 103 because it is under common ownership (and inventorship) with the present application.  
8 Section 103 (c) recites:

9 "Subject matter developed by another person, which qualifies as prior art  
10 under one or more of subsections (e), (f), and (g) of section 102 of this title,  
11 shall not preclude patentability under this section where the subject matter  
12 and the claimed invention were, at the time the invention was made, owned  
13 by the same person or subject to an obligation of assignment to the same  
14 person."

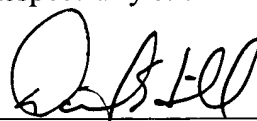
15 Thus, just as a patent issued to the same inventive entity cannot be prior art by admission, an  
16 application issued to the same inventive entity cannot be prior art under 35 U.S.C. § 103. Both the  
17 subject application and Wang are assigned to Bruker Daltonics Inc. These assignments may be  
18 found at Reel 012661, Frame 0783 and Reel 011961, Frame 0900 for the present application and  
19 Wang, respectively. For the Examiner's convenience, copies of these assignment recordings are  
20 attached. Moreover, at the time the invention of the subject application was made, the inventor had  
21 an obligation to assign his invention to Bruker Daltonics Inc., then already the assignee of Wang.  
22 For these reasons, Wang is not prior art against the subject application. Accordingly, Applicant  
23 requests that the Examiner's rejection of Claims 1-47 under 35 U.S.C. § 103 (a) as being

1 unpatentable over Wang be withdrawn.

2 In view of the foregoing, applicant respectfully submits that the present invention represents  
3 a patentable contribution to the art and that Claims 1-47 are in condition for allowance. Early and  
4 favorable action is accordingly solicited.

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Respectfully submitted,



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David M. Hill  
Reg. No. 46,170  
WARD & OLIVO  
708 Third Avenue  
New York, New York 10017  
(212) 697-6262